

ESTTA Tracking number: **ESTTA511437**

Filing date: **12/17/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207433
Party	Plaintiff Beyond Dental & Health, Inc.
Correspondence Address	JOHN K BUCHE BUCHE & ASSOCIATES PC 875 PROSPECT, SUITE 305 LA JOLLA, CA 92037 UNITED STATES jbuche@buchelaw.com, lmolnar@buchelaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Lindsay D. Molnar
Filer's e-mail	lmolnar@buchelaw.com, jbuche@buchelaw.com, gryn@buchelaw.com
Signature	/ldm/
Date	12/17/2012
Attachments	Motion for Suspension.pdf (26 pages)(2355096 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial Nos. 85/609,438 and 85/607,341

Published in the Official Gazette: September 11, 2012

For the Marks: BEYOND WHITE (Stylized Design) and BEYOND WHITE NON-PEROXIDE
TEETH WHITENING

BEYOND DENTAL AND HEALTH, INC.,
a Texas Corporation,

Registrant,

v.

Thanh Thuy Dao Vo, an individual,

Applicant.

MOTION FOR SUSPENSION

Opposer Beyond Dental And Health, Inc. (“Opposer”) moves for a suspension of the above-stylized opposition proceeding pursuant to Trademark Rule of Practice 2.117(a). *See* 37 C.F.R. § 2.117(a). Opposer has filed a Complaint against Applicant and her related company in the U.S. Southern District of California alleging causes of action for: (i) Trademark Infringement under 15 U.S.C. § 1114; (ii) Unfair Competition under 15 U.S.C. § 1125(a); (iii) Common Law Trademark Infringement; (iv) Common Law Unfair Competition; (v) Unfair Competition pursuant to *Cal. Bus. & Prof. Code* §17200; and (vi) Declaratory Judgment Regarding Infringement and Lack of Entitlement to Registration. Accordingly, the parties are engaged in a civil action which may have a bearing on this opposition proceeding, as the marks at issue in the civil action are the same marks at issue in this opposition, namely, Application Serial Nos. 85/609,438 and

85/607,341. As such, Opposer seeks suspension of this proceeding pending the conclusion and/or termination of the aforementioned civil action.

Opposer attaches as **Exhibit 1** to this Motion for Suspension a copy of the Complaint filed in the U.S. District Court, Southern District of California, as well as a copy of the Notice of Electronic filing.

Dated: December 17, 2012

Respectfully Submitted,

By: /Lindsay D. Molnar/

John Karl Buche (SBN 239477)
Lindsay Molnar (SBN 275156)
BUCHÉ & ASSOCIATES, P.C.
875 Prospect, Suite 305
La Jolla, CA 92037
Telephone: 858.459.9111
Facsimile: 858.459.9120
jbuche@buchelaw.com
lmolnar@buchelaw.com

ATTORNEYS FOR REGISTRANT,
BEYOND DENTAL AND HEALTH

CERTIFICATE OF MAILING

On **December 17, 2012**, I served the following **MOTION FOR SUSPENSION** on the following interested parties in this action:

Matthew H. Swyers
The Trademark Company
344 Maple Ave W Ste 151
Vienna, VA 22180-5612
mswyers@thetrademarkcompany.com
info@thetrademarkcompany.com
Attorney for Applicant

In the manner of service as follows:

 X **(U.S. MAIL):** I placed an original or a true and correct copy of the foregoing document(s) in a sealed envelope(s) addressed as indicated above. I am “readily familiar” with the firm’s practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the United States Postal Service on that same day with postage thereon fully prepaid as La Jolla, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

 X **(ELECTRONIC MAIL):** I emailed a true and correct copy of the foregoing document(s) on the parties listed above by transmitting it via .pdf email to the email addresses set forth above.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct. Executed on **Monday, December 17, 2012** at La Jolla, California.

By: /Celia Balog/

CERTIFICATE OF TRANSMITTAL

This is to certify that the attached Motion for Suspension is being filed electronically with the TTAB via ESTTA on December 17, 2012.

/Lindsay D. Molnar/

Attorney for Opposer

EXHIBIT 1

File a New Civil Case - Attorney

U.S. District Court

Southern District of California

Notice of Electronic Filing

The following transaction was entered by Buche, John on 12/17/2012 at 5:36 PM PST and filed on 12/17/2012

Case Name: Plaintiffs v. Defendants

Case Number: [3:12-cv-99999](#)

Filer:

Document Number: [1751](#)

Docket Text:

New Civil Case documents submitted (Filing fee received: \$ 350 receipt number 0974-5446213.) Plaintiff: Beyond Dental, Defendant: Thanh Thuy Dao Vo (Attachments: # (1) Exhibit A, # (2) Exhibit B, # (3) Civil Cover Sheet)(Buche, John)

No public notice (electronic or otherwise) sent because the entry is private

The following document(s) are associated with this transaction:

Document description:Main Document

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1106146653 [Date=12/17/2012] [FileNumber=6803547-0] [b6cce19d3218cf973c273e1040ea0a755dc694485e5e5d94280621984eb477b3f8f4212023094f00ac6a7e3fa51a174dd79d57bacffc1635156838a8660f14fd]]

Document description:Exhibit A

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1106146653 [Date=12/17/2012] [FileNumber=6803547-1] [c1458f7afd94bc52ef66df911f8b61698935b9d2660733441fb69367fe17f783e30abda52fe8e42532b7615e11651d4e664c63277178094916282406da08432d]]

Document description:Exhibit B

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1106146653 [Date=12/17/2012] [FileNumber=6803547-2] [64c9f5bd46bd6e43cb3926062db315cf67182eb9f9af0b4c1b94ffe24ce7d732791a61e35b3e78a8f7e62ee43eeab3502c7507935316492b3c5423674fe968ba]]

Document description: Civil Cover Sheet

Original filename:n/a

Electronic document Stamp:

[STAMP dcecfStamp_ID=1106146653 [Date=12/17/2012] [FileNumber=6803547-3] [12cc218e6f767537bf2744c44a51fbb38f0a2ce16579cec5ee469dea6f3cbf81688e9aed5abdc14dd1293f2d64fdb0e60e737abdd85727147f11ec93708608ef]]

John Karl Buche (SBN 239477)
Lindsay D. Molnar (SBN 275156)
BUCHE & ASSOCIATES, P.C.
875 Prospect, Suite 305
La Jolla, California 92037
Telephone: 858.459.9111
Facsimile: 858.459.9120
jbuche@buchelaw.com
lmolnar@buchelaw.com

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

BEYOND DENTAL AND HEALTH, INC.,)
a Texas corporation,)
Plaintiff,)

vs.)

**THANH THUY DAO VO A/K/A “DIANE
VO” and BRITE IMPRESSIONS LLC, a**
Nevada limited liability corporation,
Defendants.)

Case No.: _____

**COMPLAINT FOR DAMAGES AND
INJUNCTIVE RELIEF**

**(1) TRADEMARK INFRINGEMENT
UNDER 15 U.S.C. § 1114;**

**(2) UNFAIR COMPETITION UNDER 15
U.S.C. § 1125(a);**

**(3) COMMON LAW TRADEMARK
INFRINGEMENT;**

**(4) COMMON LAW UNFAIR
COMPETITION;**

**(5) UNFAIR COMPETITION PURSUANT
TO CAL. BUS. & PROF. CODE §17200;
AND**

(5) DECLARATORY JUDGMENT

JURY TRIAL DEMANDED

COMPLAINT

Beyond Dental and Health, Inc., for its Complaint, states as follows:

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2. Defendant Thanh Thuy Dao Vo a/k/a “Diane Vo” (hereafter, “Defendant Vo”) is, upon information and belief, an individual and the moving, conscious, and active force behind the infringing acts at issue, and actively participated and directed, controlled, or approved the acts herein. Upon information and belief, Defendant Vo maintains business addresses at 9360 Flamingo Road, Suite 110-266, Las Vegas, Nevada 89102 and 4300 Spring Mountain Road, #120, Las Vegas, Nevada 89102.

3. Brite Impressions LLC (“Brite Impressions”), upon information and belief, is a revoked corporation originally organized under the laws of the State of Nevada, with offices at 3850 W. Desert Inn Rd, Suite 105, Las Vegas, Nevada 89102.

4. This is a complaint for Trademark Infringement and Unfair Competition arising under Sections 32 and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) & 1125(a), and for related claims of trademark infringement and unfair competition under California state statutory and common law.

5. This Court may declare the rights and other legal relations of the parties in this case under 28 U.S.C. § 2201 and Rule 57, *Fed.R.Civ.P.*, because an actual and justiciable controversy exists concerning the rights of, and legal relations between, Plaintiff and Defendants.

6. This Court has original subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a) and 15 U.S.C. § 1121 and 1125(a). This Court has supplemental jurisdiction over any state law claims pursuant to 28 U.S.C. §§ 1338(b) and 1367.

7. This Court has personal jurisdiction over Defendants because, on information and belief, they transact business in the State of California and in this District. On information and

1 belief, a substantial part of the events giving rise to the claims alleged herein occurred in the
2 State of California and infringement has occurred and is continuing to occur in the State of
3 California.

4 8. Venue is proper in this District under 28 U.S.C. § 1391 (c) because Defendants
5 are subject to personal jurisdiction in this District, and, on information and belief, conduct
6 business in this District by the advertising, distributing, offering for sale, and selling, of goods
7 bearing the infringing mark.

8 9 **FACTS**

10 **A. Beyond Dental's Registered Trademark**

11 9. Beyond Dental is a company that sells, among other things, dental and teeth
12 whitening products. Since 2003, Beyond Dental, either by itself or through its predecessors in
13 interest, has used the mark "BEYOND" (hereafter the "Beyond Mark") in connection with the
14 sales of its teeth whitening products. Through hard work and devotion, attention to detail and
15 quality products, Beyond Dental has gained industry-wide recognition for its various products.

16 10. On or about November 6, 2002, in connection with its planned adoption and use
17 of the Beyond Mark, Beyond Dental registered the domain <<http://www.beyonddent.com>>.
18 Beyond Dental actively maintains this website to this day, and markets its wide range of dental
19 and teeth whitening products to customers through the site.

20 11. On October 27, 2009, Beyond Dental applied to register the Beyond Mark with
21 the United States Patent and Trademark Office ("PTO") in the following international classes:

22 Class 003 — *Teeth whitening preparations; toothpaste; mouthwash; non-medicated*
23 *lip care preparations; teeth whitening kits composed of teeth whitening preparation,*
24 *toothpaste, lip protection preparation, and cheek retractor; teeth whitening kits*
25 *composed of teeth whitening preparation, tooth polishing sand, cheek retractor, face*
26 *protection cloth, lip protection preparation, fluoride preparation, and toothpaste;*
27 *strips containing a preparation for promoting teeth whitening for application on a*
28 *user's teeth in a teeth whitening procedure; teeth whitening kits composed of teeth*
whitening preparation, a light emitting apparatus, namely, a lamp for connection to a
cheek retractor, and a cheek retractor.

Class 010 — *Light emitting apparatuses, namely, lamps for teeth whitening; cheek retractors for use in a teeth whitening procedure; electronic shade takers for detecting tooth shade information.*

Class 021 — *Dental floss.*

12. On January 4, 2011, the PTO approved the application and issued a Certificate of Registration under Registration Number 3,898,646 (“the ’646 registration”). A copy of the ’646 registration certificate is attached as **Exhibit A**.

13. Since it began using the Beyond Mark, Beyond Dental has widely used the Beyond Mark to market its business and dental products, including in various advertising materials and publications, on its website, and at trade shows around the world—and continues to do so to this day.

14. Beyond Dental has devoted substantial time, effort and resources to the development and promotion throughout interstate and foreign commerce of the United States of the Beyond Mark, and of the goods sold under the mark. Beyond Dental has also expanded its use of the Beyond Mark into a family of products associated with dental care, including whitening accelerator apparatuses, curing lights, composite and related products, cheek retractors, and a variety of whitening kits.

15. As a result of Beyond Dental’s promotional efforts, the purchasing public has come to know, rely upon and recognize the Beyond Mark as indicating the source of Beyond Dental’s high quality teeth whitening kits and related dental products. By virtue of Beyond Dental’s marketing efforts and expenditures, and as a result of the excellence of its products, the Beyond Mark has achieved a distinctive and valuable reputation and degree of goodwill.

B. Defendants Infringing Activities

16. Beyond Dental is informed and believes, and on that basis alleges, that Defendants manufacture, distribute, advertise for sale and sell dental and teeth whitening services and products under the name “BEYOND WHITE” and “BEYOND WHITE NON-PEROXIDE TEETH WHITENING.”

1 17. On April 25, 2012, Defendant Vo filed an application (Serial No. 85/609,438) with the
2 United States Patent & Trademark Office (“PTO”) for the purported mark “BEYOND WHITE
3 NON-PEROXIDE TEETH WHITENING” (hereinafter referred to as the “Infringing Design
4 Mark”) in Class 003 for “Foam cleaning preparations; Mouth washes; Non-medicated mouth
5 rinse; Teeth cleaning lotions; Teeth whitening kit; Teeth whitening strips impregnated with teeth
6 whitening preparations; Tooth whitening creams; Tooth whitening gels; Tooth whitening pastes;
7 Tooth whitening preparations.”

8 18. On April 26, 2012, Defendant Vo filed another application with the PTO (Serial No.
9 85/607,341) for “BEYOND WHITE” in Class 003 for “Beauty creams; Beauty lotions; Body
10 cream; Breath freshening sprays; Cosmetic creams; Cosmetic preparations; Cosmetic
11 preparations for eye lashes; Dental bleaching gel; Eye liner; Eyebrow pencils; Facial cleansers;
12 Lip gloss; Lipstick; Mascara; Moisturizing preparations for the skin; Mouthwash; Non-
13 medicated anti-aging serum; Non-medicated balms for use on the hands, body and face; Non-
14 medicated dental rinse; Skin toners; Skin whitening creams; Teeth whitening kit; Tooth
15 whitening preparations; Toothpaste” (the “Infringing BW Mark”, and collectively with the
16 Infringing Design Mark, the “Infringing Marks”)

17 19. An example of Defendants’ “BEYOND WHITE” and “BEYOND WHITE NON-
18 PEROXIDE TEETH WHITENING” product packaging and advertising is attached herewith as
19 **Exhibit B**. Upon information and belief, the Defendants sell teeth whitening products under the
20 Infringing Marks.

21 20. Beyond Dental is informed and believes, and on that basis alleges, that Defendants
22 specifically provide teeth whitening services and/or sell teeth whitening products and kits.
23 Beyond Dental is informed and believes, and on that basis alleges, that Defendants are direct
24 competitors of Beyond Dental in this respect. On information and belief, these products are sold
25 throughout the U.S. and in this district using the Beyond Mark. Beyond Dental is informed and
26 believes, and based thereon alleges, that Defendants’ goods are sold in the same channels of
27 trade as those of Beyond Dental. In short, both companies offer whitening kits or systems, and
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1 both use the term “Beyond” to do so.

2 21. Beyond Dental learned of Defendants entry into the dental and teeth whitening market
3 under the name “BEYOND,” on or about September of 2012, when the applications for the
4 Infringing Marks were published in the Trademark Official Gazette. In response, on October 10,
5 2012, Beyond Dental filed a Notice of Opposition to the registration of the Infringing Marks in
6 the Trademark Trial and Appeal Board (“TTAB”). This opposition proceeding is still pending
7 before the TTAB as Opposition No. 91207433.

8 22. Despite Beyond Dental’s notice of opposition, Defendants, with actual notice of the
9 infringement willfully and blatantly continue to advertise and market the infringing products
10 using “BEYOND” as a mark. Said acts of infringement will cause further irreparable injury to
11 Beyond Dental if Defendants are not restrained by this Court from further violating Beyond
12 Dental’s rights, and Beyond Dental has no adequate remedy at law.

13 23. Beyond Dental is informed and believes, and on that basis alleges, that Defendant
14 Diane Vo is personally involved and knowingly contributes to the willful infringement of the
15 Beyond Mark.

16 24. Beyond Dental is informed and believes, and on that basis alleges, that Defendants have
17 acted with full knowledge of Beyond Dental’s prior use of the Beyond Mark and the parties
18 directly compete in the teeth whitening industry.

19 25. Because Beyond Dental’s and Defendants’ products are directly competitive, it is
20 natural for consumers to assume that said products and their sources are associated, somehow
21 affiliated, or sanctioned. Such a result significantly undermines Beyond Dental’s substantial
22 efforts to establish its identity in this field.

23 26. Beyond Dental has no control over the nature and quality of Defendants’ products.
24 Any failure, neglect or default by Defendants in providing such products will reflect adversely
25 on Beyond Dental as the believed source of origin thereof, hampering efforts by Beyond Dental
26 to continue to protect its reputation for high quality products. This will cause Beyond Dental to
27 lose sales and the benefit of its considerable expenditures to promote its products under its
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Beyond Mark, and related “Beyond Dental” family of marks, all to Beyond Dental’s detriment.

27. Beyond Dental is informed and believes, and on that basis alleges, that Defendants have acted willfully, in bad faith, and maliciously violated Beyond Dental’s trademark rights, with the intent to confuse and mislead the public and unfairly trade on the substantial and valuable goodwill encompassed by the Beyond Mark.

28. Beyond Dental is in need of injunctive relief to bring an end to the irreparable harm caused by the Defendants’ use of the Beyond Mark to offer competing products that infringe Beyond Dental’s trademark rights. Without an injunction, Defendants undoubtedly will continue to sell the infringing services and cause additional confusion in the marketplace.

Count I

Federal Trademark Infringement-Violation of Section 32 of the Lanham Act

29. Beyond Dental repeats and realleges each and every allegation contained in paragraphs 1–28 of the complaint as though fully set forth herein.

30. By the acts and omissions set forth above, Defendants, and each of them, have infringed and continue to infringe Beyond Dental’s rights in the Beyond Mark and the ’646 registration, in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114. Defendants’, and each of their conduct is likely to cause confusion, mistake and deception among the general purchasing public, and interfere with Beyond Dental’s ability to use its mark to indicate a single quality controlled source of goods.

31. Beyond Dental has suffered, is suffering, and will continue to suffer irreparable injury for which Beyond Dental has no adequate remedy at law. Beyond Dental is therefore entitled to preliminary and permanent injunctive relief against Defendants’ further infringing conduct.

32. Defendants have profited and are profiting from such infringement, and Beyond Dental has been and is being damaged by such infringement. Beyond Dental is therefore entitled to recover damages from Defendants in an amount to be proven at trial as a consequence of Defendants’ infringing activities.

33. Beyond Dental is informed and believes, and on that basis alleges, that Defendants’,

1 and each of their aforesaid acts and infringing conduct has been willful, wanton and malicious,
2 and done with the intent to deceive. Beyond Dental therefore is entitled to an award of its
3 reasonable attorneys' fees and costs, and treble its actual damages, pursuant to 15 U.S.C. §
4 1117(a). Beyond Dental also is entitled to, among other things, the cost of corrective
5 advertising.

6 **Count II**

7 **Federal False Designation of Origin—Violation of Section 43(a) of the Lanham Act**

8 34. Beyond Dental repeats and realleges each and every allegation contained in
9 paragraphs 1–33 of the complaint as though fully set forth herein

10 35. By the acts and omissions set forth above, Defendants, and each of them, have
11 infringed and continue to infringe Beyond Dental's rights in the Beyond Mark, in violation of
12 Lanham Act §43(a), 15 U.S.C. § 1125(a). Defendants', and each of their conduct is likely to
13 cause confusion, mistake and deception among the purchasing public, and interfere with Beyond
14 Dental's ability to use the Beyond Mark to indicate a single quality-controlled source of goods
15 and services. Defendants', and each of their acts as alleged herein also constitute false
16 designation of origin, unfair competition and false advertising in violation of Lanham Act §
17 43(a), 15 U.S.C. §1125(a).

18 36. Beyond Dental has suffered, is suffering, and will continue to suffer irreparable
19 injury for which Beyond Dental has no adequate remedy at law. Beyond Dental is therefore
20 entitled to a preliminary and permanent injunction against Defendants' further infringing
21 conduct.

22 37. Defendants have profited and are profiting from such infringement, and Beyond
23 Dental has been and is being damaged by such infringement. Beyond Dental is therefore entitled
24 to recover damages from Defendants in an amount to be proven at trial as a consequence of
25 Defendant's infringing activities.

26 38. Beyond Dental is informed and believes, and on that basis alleges, that
27 Defendants', and each of their aforesaid infringing conduct has been willful, wanton and
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malicious, and done with the intent to deceive. Beyond Dental therefore is entitled to an award of its reasonable attorneys' fees and costs, and treble its actual damages, pursuant to 15 U.S.C. § 1117(a). Beyond Dental also is entitled to, among other things, the cost of corrective advertising.

Count III

Common Law Trademark Infringement

35. Beyond Dental repeats and realleges each and every allegation contained in paragraphs 1–34 of the complaint as though fully set forth herein.

36. Defendants unauthorized use of the Infringing Marks is likely to cause confusion, deception, and mistake by creating the false and misleading impression that the Defendants' products and services are provided or distributed by Beyond Dental, associated or connected with Beyond Dental, or have the sponsorship, endorsement, or approval of Beyond Dental, in violation of the common law.

37. Defendants' misconduct resulting in such actual and likelihood of confusion, deception, and mistake will continue unless enjoined by this Court.

38. Defendants' acts, as complained of herein, have caused irreparable injury and damage to Plaintiff, and, unless restrained, will continue to do so. Plaintiff has no adequate remedy at law.

39. Plaintiff has suffered and continued to suffer economic loss directly and proximately caused by Defendants' actions alleged herein.

Count IV

Common Law Unfair Competition

39. Beyond Dental repeats and realleges each and every allegation contained in

1 paragraphs 1–38 of the complaint as though fully set forth herein.

2 40. Plaintiff first adopted and used the Beyond Mark in its market or trade area, as a
3 means of establishing good will and reputation and to describe, identify or denominate particular
4 goods or services rendered or offered by Plaintiff, and to distinguish them from similar goods or
5 services rendered or offered by others.

6 41. The Defendants have commenced the use of an identical or confusingly similar
7 trade name or mark, to indicate or identify similar services rendered by it in competition with
8 Plaintiff, in the same trade area in which Plaintiff has already established its trade name or mark.

9 42. As a consequence of the Defendants’ action, customer confusion of source or as
10 to the sponsorship of the goods and services offered by the Defendants is likely.

11 43. Beyond Dental is informed and believes and based thereon alleges that
12 Defendants’, and each of their acts were malicious, fraudulent and oppressive, justifying an
13 award of punitive damages in an amount according to proof such that Defendants will not engage
14 in such conduct in the future and have it serve as an example to others.

15 44. Plaintiff has no adequate remedy at law.

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19 **Count V**

20 **Unfair Competition Pursuant to *Cal. Bus. & Prof. Code §17200***

21 45. Beyond Dental repeats and realleges each and every allegation contained in
22 paragraphs 1–44 of the complaint as though fully set forth herein.

23 46. Beyond Dental is informed and believes, and thereupon alleges, that in the course
24 of conducting Defendants’ business, Defendants knowingly made false representations as to the
25 affiliation, connection, and/or association with Beyond Dental by using a mark confusingly
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1 similar to the Beyond Mark and otherwise engaged in deceptive trade practices which constitute
2 unfair competition under *Cal. Bus. & Prof. Code* §17200.

3 47. As the direct and proximate result of Defendants' conduct, Beyond Dental has
4 suffered, and will continue to suffer, monetary damages and irreparable injury to its business,
5 reputation, and goodwill. Specifically, Defendants' acts have caused Beyond Dental competitive
6 injury, as described herein, and have caused Beyond Dental to incur damages in an amount to be
7 proven at trial consisting of, among other things, diminution in the value of and goodwill
8 associated with the Beyond Mark.
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10 **Count VI**

11 **Declaratory Judgment Regarding Infringement and Lack of Entitlement to Registration**

12 48. Beyond Dental repeats and realleges each and every allegation contained in
13 paragraphs 1–47 of the complaint as though fully set forth herein.
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15 49. There is an actual, substantial, and justiciable controversy between Beyond Dental
16 and Defendants, concerning Defendants' entitlement to obtain federal registration of its proposed
17 marks, subject of federal trademark application Serial Nos. 85/607,341 and 85/609,438, and the
18 likelihood of confusion of such marks with the Beyond Mark.
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20 50. Beyond Dental is entitled to a judgment declaring that Defendants are not entitled
21 to obtain federal registration of application Serial Nos. 85/607,341 and 85/609,438, or any other
22 marks used by Defendants which consist of or incorporate the term "BEYOND", due to a
23 likelihood of confusion with Beyond Dental's prior registered and common law Beyond Mark.
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25 51. As a direct and proximate cause of Defendants' alleged acts, Beyond Dental is
26 suffering or will suffer irreparable injury in an amount that cannot presently be ascertained, and
27 cannot be adequately compensated by monetary relief alone.
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1 **PRAYER FOR RELIEF**

2 WHEREFORE, Plaintiff Beyond Dental prays for judgment that:

3 1. Judgment be entered that:

- 4 a) Defendants have violated Section 32(a) of the Lanham Act, 15 U.S.C. § 1114(a);
5 b) Defendants have violated Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);
6 c) Defendants have engaged in trademark infringement under the common law; and
7 d) Defendants have engaged in deceptive trade practices under *California Business and*
8 *Professions Code* § 17200, *et.seq.*

9 2. That, pursuant to 15 U.S.C. § 1116 or relevant California law, Defendants and their
10 officers, agents, servants, distributors, affiliates, employees, attorneys and representatives, and
11 all those in privity or acting in concert with each Defendant, or on behalf of any Defendant, be
12 preliminarily and permanently enjoined and restrained from, directly or indirectly:

- 13 a) Using the Beyond Mark, and any other mark similar thereto;
14 b) Falsely designating the origin, sponsorship, or affiliation of Defendants' products as
15 those of Beyond Dental;
16 c) Otherwise competing unfairly with Beyond Dental in any manner;
17 d) Using any trade practices whatsoever, including those complained of herein, which
18 tend to unfairly compete with or to injure Beyond Dental's business and the goodwill
19 pertaining thereto; and
20 e) Continuing to perform in any manner whatsoever any of the acts complained of in
21 this complaint.

22 3. For an assessment of the damages suffered by Beyond Dental, trebled due to the
23 exceptional nature of the case, including an award of all gains, advantages, and profits that
24 Defendants have derived while using the Infringing Marks, as well as costs, prejudgment
25 interest, and attorney's fees to the full extent provided for by Section 35 of the Lanham Act, 15
26 U.S.C. § 1117; and awarding profits, damages, and fees, to the full extent available, pursuant to
27 the laws of California, including any and all available punitive damages, as well as, attorneys'
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1 fees and costs.

2 4. For declaratory judgment that Defendants are not entitled to obtain federal registration of
3 any currently pending application for a mark consisting of or incorporating the term
4 “BEYOND”, and that any use of such marks by Defendants in commerce constitutes
5 infringement of the Beyond Mark. .

6 5. That Defendants be ordered to pay Plaintiff restitution for violation of *California*
7 *Business and Professions Code* §17200, *et.seq.*

8 6. Defendants be required to deliver up for destruction all products bearing the Beyond
9 Mark, pursuant to 15 U.S.C § 1118, or any other applicable law.

10 7. Defendants pay Beyond Dental’s costs of corrective advertising.

11 8. Beyond Dental be awarded such other and further relief as the Court may deem just and
12 proper.

13
14 Respectfully Submitted,

15 Dated: December 17, 2012

16 s/ John K. Buche
17 John Karl Buche, Esq.
18 California Bar No. 239477
19 Texas Bar No.: 24012352
20 jbuche@buchelaw.com
21 **BUCHE AND ASSOCIATES, P.C.**
22 875 Prospect, Suite 305
23 La Jolla, California 92037
24 Telephone (858) 459-9111
25 Facsimile (858) 459-9120

26 *Attorneys for Plaintiff*
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Dated: December 17, 2012

s/ John K. Buche
John Karl Buche, Esq.
California Bar No. 239477
Texas Bar No.: 24012352
jbuche@buchelaw.com
BUCHE AND ASSOCIATES, P.C.
875 Prospect, Suite 305
La Jolla, California 92037
Telephone (858) 459-9111
Facsimile (858) 459-9120

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EXHIBIT A

United States of America

United States Patent and Trademark Office

BEYOND

Reg. No. 3,898,646

Registered Jan. 4, 2011

Int. Cls.: 3, 10 and 21

TRADEMARK

PRINCIPAL REGISTER

BEYOND DENTAL & HEALTH, INC. (TEXAS CORPORATION)
12503 EXCHANGE DR., SUITE 558
STAFFORD, TX 77477

FOR: TEETH WHITENING PREPARATIONS; TOOTHPASTE; MOUTHWASH; NON-MEDICATED LIP CARE PREPARATIONS; TEETH WHITENING KITS COMPOSED OF TEETH WHITENING PREPARATION, TOOTHPASTE, LIP PROTECTION PREPARATION, AND CHEEK RETRACTOR; TEETH WHITENING KITS COMPOSED OF TEETH WHITENING PREPARATION, TOOTH POLISHING SAND, CHEEK RETRACTOR, FACE PROTECTION CLOTH, LIP PROTECTION PREPARATION, FLUORIDE PREPARATION, AND TOOTHPASTE; STRIPS CONTAINING A PREPARATION FOR PROMOTING TEETH WHITENING FOR APPLICATION ON A USER'S TEETH IN A TEETH WHITENING PROCEDURE; TEETH WHITENING KITS COMPOSED OF TEETH WHITENING PREPARATION, A LIGHT EMITTING APPARATUS, NAMELY, A LAMP FOR CONNECTION TO A CHEEK RETRACTOR, AND A CHEEK RETRACTOR, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 1-15-2003; IN COMMERCE 1-15-2003.

FOR: LIGHT EMITTING APPARATUSES, NAMELY, LAMPS FOR TEETH WHITENING; CHEEK RETRACTORS FOR USE IN A TEETH WHITENING PROCEDURE; ELECTRONIC SHADE TAKERS FOR DETECTING TOOTH SHADE INFORMATION, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 1-15-2003; IN COMMERCE 1-15-2003.

FOR: DENTAL FLOSS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 10-30-2006; IN COMMERCE 10-30-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-857,893, FILED 10-27-2009.

GRETCHEN ULRICH, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

EXHIBIT B

NEW

USE AFTER
WHITENING

beyond  white
NON-PEROXIDE TEETH WHITENING

Mouth Rinse


PEPPERMINT

MADE IN USA

Net Wt. 1.0 fl. oz./ 30 mL



CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

I. (a) PLAINTIFFS

BEYOND DENTAL AND HEALTH, INC.,
a Texas corporation,

(b) County of Residence of First Listed Plaintiff Stafford, Texas
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorneys (Firm Name, Address, and Telephone Number)
John Karl Buche (SBN 239477), Lindsay D. Molnar (SBN 275156)
BUCHÉ & ASSOCIATES, P.C., 875 Prospect, Suite 305
La Jolla, California 92037, (858) 459-9111

DEFENDANTS

THANH THUY DAO VO A/K/A "DIANE
VO" and BRITE IMPRESSIONS LLC

County of Residence of First Listed Defendant Clark County, Nevada
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF
THE TRACT OF LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
☒ 3 Federal Question (U.S. Government Not a Party)
☐ 2 U.S. Government Defendant
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES	
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 362 Personal Injury - Med. Malpractice	PERSONAL INJURY <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 367 Health Care/Pharmaceutical Personal Injury Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 751 Family and Medical Leave Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act IMMIGRATION <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 463 Habeas Corpus - Alien Detainee (Prisoner Petition) <input type="checkbox"/> 465 Other Immigration Actions	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 375 False Claims Act <input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 896 Arbitration <input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 440 Other Civil Rights <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 448 Education	PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate Sentence Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 560 Civil Detainee - Conditions of Confinement			

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
☐ 2 Removed from State Court
☐ 3 Remanded from Appellate Court
☐ 4 Reinstated or Reopened
☐ 5 Transferred from another district (specify)
☐ 6 Multidistrict Litigation

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
 Sections 32 and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) & 1125(a), 28 U.S.C. § 2201

Brief description of cause:

Trademark Infringement, Unfair Competition, Declaratory Judgment

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

Unspecified

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

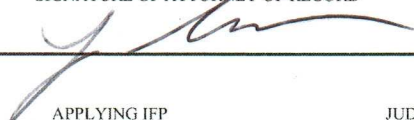
JUDGE

DOCKET NUMBER

DATE

12/17/2012

SIGNATURE OF ATTORNEY OF RECORD



CA Bar # 275156

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE